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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,909	02/24/2004	Bryan M. Herrera	MATC101	4402
7590	11/29/2005		EXAMINER	
DEREK H. MAUGHAN DYKAS, SHAVER & NIPPER, LLP P.O. BOX 877 BOISE, ID 83701-0877			POLLICOFF, STEVEN B	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

T.L.H.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/786,909	HERRERA, BRYAN M.	
	Examiner	Art Unit	
	Steven B. Pollicoff	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 2/24/04.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 24 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/21/04</u> .	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
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**DETAILED ACTION**

***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "hinge" as claimed in Claim 4 and 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the

description: see Specification: Page 8, Paragraph [0024], Line 4, "...a hinge 28".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

3. The disclosure is objected to because of the following informalities: See Specification: Page 9, Paragraph [0026], Line 9. The sentence reads, "At pair of work surface pads 30,40 are attached to the body." "At" should be corrected to read "A." Reference number "30" seems to be a typing error and should be corrected to read "38." The sentence should read, "A pair of work surface pads 38,40 are attached to the body."

Appropriate correction is required.

#### ***Claim Objections***

4. Claims 9, 14, and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 is a duplicate of Claim 2, Claim 14 does not limit or narrow Claim 11, and Claim 19 is a duplicate of Claim 12.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 1, it is unclear whether the "at least one pounding surface" is a separate element connected to the body, an area of the body itself, or an area of the lid. For examination purposes the Examiner will consider the "at least one pounding surface" to be an area of the lid.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4,6,7,9-14,16,17,19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Feder (U.S. Pat. No. 5,628,400).

9. As to Claim 1, Feder discloses a combination tool holder and work station comprising a body (see Feder Fig. 1, reference number 10), a plurality of chambers (see Fig. 4 generally) to receive tools (see Column 1, Lines 17-18), a lid (see Fig. 1,

reference number 34) to connect with said body so as to hold tools within the chambers, and at least one pounding surface connected to the body (see Fig. 1, reference number 34).

10. As to Claim 2 and 12, Feder discloses a second pounding surface (see Fig. 3, reference number 20).

11. As to Claim 3 and 13, Feder discloses that the body is comprised of a durable plastic material (see Column 1, Line 16).

12. As to Claim 4 and 14, Feder discloses that the lid is connected to the body through a hinge (see Fig. 1 generally; Fig. 4, reference number 37; Column 3, Lines 43-46).

13. As to Claim 6 and 16, Feder discloses that the chambers are capable of being configured for eyelet setting tools (see Column 2, Lines 27-29).

14. As to Claim 7 and 17, Feder discloses that the lid is configured to fit within a portion of the body. Fig. 1 shows that the body declines at the point where the lid is hinged to the body. When the lid is closed, the portion that rests on the decline is within a portion of the body.

15. As to Claim 9 and 19, see rejection as to Claim 2 above.

16. As to Claim 11, Feder discloses a combination tool holder and work station comprising a body (see Fig. 1, reference number 10) having a top and a bottom (see Fig. 4 generally), a plurality of chambers (see Fig. 4 generally) to receive tools (see Column 1, Lines 17-18), a lid (see Fig. 1, reference number 34) connected to the body through a hinge (see Fig. 1 generally; Fig. 4, reference number 37; Column 3, Lines 43-

46) to connect with said body so as to hold tools within the chambers, and at least one pounding surface connected to the body (see Fig. 1, reference number 34).

17. Claims 1, 10, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Germano (U.S. Pat. No. 6,113,202).

18. As to Claim 1, Germano discloses a combination tool holder and work station comprising a body (see Germano Fig. 1, reference number 10), a plurality of chambers (see Fig. 5, reference numbers 42 and 20) to receive tools (see Fig. 5 generally), a lid (see Fig. 1, reference number 52) to connect with said body so as to hold tools within the chambers (see Column 2, Lines 60-64), and at least one pounding surface connected to the body (see Fig. 1, reference number 52).

19. As to Claims 10 and 20, Germano discloses a tool holder where the second pounding surface is made of a material different than the first pounding surface. The pounding surfaces can be of various materials or even a combination of materials depending on the particular application and user's needs (see Germano Column 6, Lines 66-67; Column 7, Lines 1-2).

#### ***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder in view of Henke et al., (U.S. Pat. No. 5,398,809).

22. As to Claims 5 and 15, Feder does not disclose a combination tool holder where the body is comprised of a durable transparent material. However, Henke discloses a tool holder with a body of transparent material to facilitate viewing of the tool holder's contents. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Feder tool holder as modified by Henke to include a body made of transparent material for the purpose of being able to see the tools that are stored inside the body (see Henke Column 1, Lines 14-20; Column 2, Lines 39-42).

23. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder in view of Lee (U.S. Pat. No. 6,237,767).

24. As to Claims 8 and 18, Feder does not disclose a combination tool holder where the pounding surface is made of a durable rubber material. However, Lee discloses a tool holder with a surface made of durable rubber capable of being used as a pounding surface. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Feder tool holder as modified by Lee to include a

pounding surface made of durable rubber. Motivation for the modification comes from the inherent benefits of rubber. Examples of such benefits are that rubber can reduce noise produced from pounding, it can be hard or soft depending on the application, and it has utility as a friction material to stabilize the tool holder on a surface when not used for pounding.

25. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder in view of Germano (U.S. Pat. No. 6,113,202).
26. As to Claims 10 and 20, Feder does not disclose that the combination tool holder where the second pounding surface is made of a material different than the first pounding surface. However, Germano discloses a tool holder where the pounding surfaces can be of various materials or even a combination of materials depending on the particular application and user's needs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Feder tool holder as modified by Germano to include different materials for the first and second pounding surface for the purpose of making the tool holder durable, multifunctional, lightweight, and capable of withstanding varying degrees of work loads and forces (see Germano Column 2, Lines 24-28, 45-48; Column 6, Lines 66-67; Column 7, Lines 1-2).

### ***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Knutson (U.S. Pat. No. 5,295,742) discloses a container for tools with a work surface. Rogovin (U.S. Pat. No. 3,074,539) discloses a container with a plurality of chambers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Pollicoff whose telephone number is (571)272-7818. The examiner can normally be reached on M-F: 7:30A.M.-4:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JILA M. MOHANDESI  
PRIMARY EXAMINER